Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte TADASHI UEKUSA

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Appeal No. 1999-2307
Application No. 08/711,074

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HEARD: October 10, 2001

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Before FLEMING, LALL and BARRY, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 21, all of the claims pending in the instant application.

The present invention relates to an information recording method and apparatus for recording information on a magnetic tract or a photographic negative film by

supplying a magnetic head with a signal corresponding to the information to magnetically record on a magnetic track.

Independent claim 1 reads as follows:

An information recording method comprising the steps of:

causing relative movement between a photographic negative film, provided with a magnetic track, and a magnetic head;

supplying said magnetic head with a signal corresponding to an information to be magnetically recorded so as to magnetically record the information in a first predetermined region of said magnetic track;

recording said information on said first predetermined region of said magnetic track of said photographic negative film on the basis of said signal supplied to said magnetic head;

supplying said magnetic head with a second signal when said magnetic head is located at a second predetermined region which is outside said first predetermined region, said second signal being one of direct current and alternating current; and

operating said second signal on said second predetermined region of said photographic negative film through said magnetic head.

In rejecting Appellant's claims, the Examiner relies on the following references:

Itoh	5,453,805	Sep. 26, 1995
Kazami et al. (Kazami)	5,559,568	Sep. 24, 1996
Yoshida	5,649,249	Jul. 15, 1997

Claims 1, 2, 4 through 15 and 17 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kazami in view of Yoshida.

Claims 3 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kazami in view of Yoshida and further in view of Itoh.

OPINION

With full consideration given to the subject matter on appeal, the Examiner's rejection and the arguments of the Appellant and the Examiner, we will reverse the Examiner's rejection of claims 1 through 21.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. ***Oetiker***, 977 F.2d at 1445, 24 USPQ at 1444. ***See also Piasecki***, 745 F.2d at 1472, 223 USPQ at 788 ("After a prima facie case of obviousness has been established, the burden of going forward shifts to the applicant.").

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. ***See In re Oetiker***, 977 F.2d at 1445, 24 USPQ2d

at 1444 (“In reviewing the examiner’s decision on appeal, the Board must necessarily weigh all of the evidence and arguments.”). With these principles in mind, we commence review of the pertinent evidence and arguments of Appellant and Examiner.

Appellant argues on pages 8 and 9 of the brief that Kazami and Yoshida do not teach or suggest using a signal magnetic head for recording an information signal in one region of a photographic film and for recording a second signal of direct current or alternating current on another region of a photographic film. In particular, Appellant argues that the Examiner’s proposed modification of Kazami in which the substitution of an alternating current signal for the second information signal of Kazami but not the first information signal makes no sense. See page 2 of the reply brief.

In order for us to decide the question of obviousness, "[t]he first inquiry must be into exactly what the claims define." ***In re Wilder***, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970) “Analysis begins with a key legal question -- what is the invention claimed?”. . . Claim interpretation . . . will normally control the remainder of the decisional process.” ***Panduit Corp. v. Dennison Mfg. Co.***, 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987), ***cert denied***, 481 U.S. 1052 (1987).

We note that claim 1 reads as follows:

> supplying said magnetic head with a signal corresponding to an information to be magnetically recorded so as to magnetically record the information in a first predetermined region of said magnetic track . . .
> supplying said magnetic head with a second signal when said magnetic head is located at a second predetermined region which is outside said first predetermined region, said second signal being one of direct current and alternating current

We note that the other independent claims 10 and 14 recite similar language. Thus, the claims require a magnetic head for recording an information signal in one region on a photographic head and for recording a second signal which is direct current or alternating current on another region of said photographic film.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that “[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem.” ***Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc***., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), ***citing In re Rinehart***, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination

of obviousness). The Federal Circuit reasons in ***Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.***, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for a determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention. "***Para-Ordnance Mfg. v. SGS Importers Int'l***, 73 F.3d at 1087, 37 USPQ2d at 1239, ***citing W.L. Gore & Assocs.***, ***Inc. v. Garlock, Inc.***, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. In addition, our reviewing court requires the Patent and Trademark Office to make specific findings on a suggestion to combine prior art references. ***In re Dembiczak***, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

On page 9 of the Examiner's answer, the Examiner states that Kazami teaches recording first and second signals. The Examiner further contends that Yoshida teaches recording of an alternating current signal as alternative specific information represents the existence of exposed frame. The Examiner argues that Kazami may be modified by Yoshida by not modifying the first signal of Kazami. The Examiner further

explains that the alternating current signal of Yoshida would only be used as the second signal of Kazami. The Examiner argues that it would have been obvious to replace the second signal of Kazami with the alternating current signal of Yoshida because it relates to exposed information.

Even if we were to agree with the Examiner that it would have been obvious to modify Kazami by substituting the alternating current signal taught by Yoshida, we fail to find that the Examiner has shown any evidence that it would have been obvious to only substitute the Yoshida alternating current signal for the second information signal of Kazami. The Examiner has not come to grips with the fact that if it would have been obvious to one of ordinary skill in the art to make the modification of Kazami using the Yoshida alternating current signal, then it would have been obvious to use the Yoshida alternating current signal for the second signal as well. The Examiner has not provided any evidence of obviousness by simply substituting the Yoshida alternating current signal for just one of the Kazami information signals.

Because neither Kazami nor Yoshida, alone or in combination, teach or suggest Appellant's claim limitation, we conclude that the Examiner has failed to establish a ***prima facie*** case. Accordingly, we reverse the Examiner's rejection of claims 1, 2, 4 through 15 and 17 through 21 as being obvious over Kazami in view of Yoshida.

Turning to the rejection of claims 3 and 16 as being unpatentable over Kazami in view of Yoshida and Itoh, we note that Itoh does not provide the missing piece of evidence which shows why one of ordinary skill in the art would only have modified one of Kazami's information signals. Therefore, we reverse the Examiner's rejection of claims 3 and 16 for the same reasons as above.

REVERSED

MICHAEL R. FLEMING Administrative Patent Judge	)
PARSHOTAM S. LALL Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

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